

REMARKS

Claims 1-49 have been cancelled and new claims 50-63 have been added. No new matter is presented by virtue of the within amendment. For instance, the within amendment is submitted, in significant part, to exclude non-elected subject matter and correct minor informalities. Support for the newly presented claims is found throughout the specification and claims as originally filed.

Amendment of any claim herein is not to be construed as acquiescence to any of the rejections/objections set forth in the instant Office Action. Such amendments are being made in an effort to expedite prosecution of the present application. Applicants make these amendments without prejudice to pursuing the original subject matter of this application in a later filed application claiming benefit of the instant application, including without prejudice to any determination of equivalents of the claimed subject matter.

At the outset, the undersigned attorney appreciates the recent opportunity to discuss the present application with the Examiner. As part of that discussion, it was agreed that "allyl" is properly included as a possible R/R' value in part a) of claim 28 (new claim 50). While no definitive agreement was reached, the opportunity for combination of certain of the remaining groups of claims set forth in the Restriction Requirement dated September 28, 2004, was discussed in connection with a further (as yet, unfiled) continuation application.

Referring now to the Office Action, Applicants appreciate the indication of allowable subject matter, i.e., that claims 32, 36, 37, 43, and 46-49 (corresponding to new claims 53, 54, 55, 59, and 60-63) would be allowable if amended to overcome the objections. In particular, the Office Action states that claims 32, 36, 37, 43, and 46-49 are merely objected to as containing non-elected subject matter, and being dependent on an objected base claim.

Favorable reconsideration of the present application is respectfully requested in light of the within amendments and remarks which follow.

35 U.S.C. §112, Second Paragraph Rejection

Claims 41 (new claim 57) and 42 (new claim 58) have been rejected under 35 U.S.C. §112, second paragraph. The Office Action alleges that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

The Office Action asserts that claim 41 specifies in the preamble that a method of producing ethers is provided, while the process step recited is that of an esterification reaction. Therefore, it is alleged that the preamble is repugnant to the actual process claimed.

Applicants have cancelled claim 41 and rewritten the subject matter thereof in new claim 57. The recitation of “esterification catalyst” has been replaced by “catalyst.” Support can be found in the specification as filed, at least on page 32, wherein “regioselective modification of the benzylic hydroxy groups is achieved either by acid or base treatment of benzylic acylates in the presence of suitable hydroxy reagents (e.g. alcohols) or by catalytic ether formation as described in the literature for other benzylic substrates.” No recitation of an esterification catalyst is indicated for the incorporation of an ether functionality onto a benzylic alcohol. Therefore, the rejection is obviated and Applicants respectfully request its withdrawal.

The Office Action further asserts that claim 42 specifies in the preamble that a method of producing ethers is provided, while the process step recited would produce many compounds in addition to ethers. For example, reactants (c) and (f) would produce esters, reactant (e) would produce a carbamate or carbonate.

Applicants have cancelled claim 42 and have added new claim 58. Claim 58 recites the process for the preparation of compounds of formula VI wherein one of R¹⁰ or R¹¹ is H. For example, reactant (c) will lose the ester functionality in the presence of an acid or base and a suitable alcohol can then be incorporated as R¹⁰O- or R¹¹O-. The

corresponding formula VI compound would include the suitable alcohol at either R¹⁰ or R¹¹ with the other R¹⁰ or R¹¹ being H. Applicants respectfully request withdrawal of the rejection.

The Office Action goes on to assert that in claim 42 (new claim 58) recitation of “suitable hydroxy reagents” is not understood to be a term of art, and that the specification does not provide sufficient definition of what compounds belong to this class of reagent. However, replacement of the phrase with “suitable alcohol” would be sufficient to overcome at least this ground of the rejection.

Applicants have replaced “suitable hydroxy reagents” with “at least one alcohol selected from R¹⁰OH and R¹¹OH” in claim 58, thus obviating the rejection. Applicants submit that the amendment provided *supra* more particularly describes the subject matter of the instant invention. Applicants respectfully request withdrawal of the rejection.

The Office Action further asserts that claim 42 (new claim 58) has not been further examined because it is unclear what compounds are produced by the process when the above pointed-out reactants are employed.

Applicants submit that claim 58 is directed towards the synthesis of compounds of formula VI. An example of this process is exemplified on page 75 of the specification as example (e), which discloses the synthesis of compounds of formula VI. Applicants therefore respectfully request withdrawal of the rejection.

35 U.S.C. §102(b) Rejection

Claims 28, 29, and 31 (new claims 50, 51, and 52) stand rejected as being anticipated by US 5,686,464 (Johanssen et al.), when R'/R¹¹ is benzyl, R/R¹⁰ is hydrogen, and X is diisopropylamine.

Applicants submit that the proviso in claim 50 (and subsequent dependent claim 51), effectively removes the compound disclosed by Johanssen. Support for the proviso can be found at least in claim 28, and claim 1 as originally filed. The same proviso is currently presented for formula VI in new claim 52. Support for the proviso of formula VI can be found at least in former claim 31. Applicants respectfully request withdrawal of the rejection.

Claim Objections

Claim 32 (new claim 53) was objected to because non-elected subject matter is recited therein. The Office Action indicates that the first five named species in claim 32 are within the elected group and are allowable.

New claim 53 recites those compounds that fall within the elected subject matter. The objection is thus obviated and Applicants respectfully request its withdrawal.

As a matter of formality, Applicants reserve the right to pursue the non-elected subject matter of this application in one or more further continuation or divisional applications.

Claims 36 and 37 (new claims 54 and 55) were objected to because non-elected subject matter is recited therein. The Office Action indicates that claims 36 and 37 would be allowable if amended to delete that non-elected subject matter. Further, claims 39 and 46-49 (new claims 56 and 60-63) would be allowable as well if amended to exclude non-elected subject matter.

Applicants submit that new claim 54 excludes non-elected subject matter. Applicants aver that claim 54 is in condition for allowance. Further, new claims 55, 56, and 60-63 are in condition for allowance as they depend, at least in part, from claim 54. Applicants respectfully request withdrawal of the objection.

It is alleged that claims 39, 43 and 46-49 (new claims 56, 59, and 60-63) are objected to because they depend from a rejected base claim and also recite non-elected subject matter, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and to delete non-elected subject matter.

Applicants aver that new claims 56 and 60-63 are in condition for allowance (*vide supra*). New claim 59 depends from claim 52, and is presented in a manner which recites only the elected subject matter. Therefore, the objection to claim 59 is obviated and Applicants indicate that claim 59, as presented, is in condition for allowance.

CONCLUSION

In view of the above amendments and the arguments presented, reconsideration and withdrawal of all rejections are respectfully solicited.

Applicants have addressed the objections and rejections provided in the outstanding Office Action, and it is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,


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